

REMARKS

Entry of this Amendment is proper under 37 C.F.R. § 1.116 because the Amendment places the application in condition for allowance for the reasons discussed herein; and does not raise any new issues requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution. Entry of the Amendment is thus respectfully requested.

As stated in the Official Action, claims 55-96 are pending in the subject application. Claim 96 stands withdrawn from consideration. Claims 55-88 and 92-95 stand rejected. Claims 89-91 stand objected to.

By way the present Amendment, claims 55, 64, 66, 68, 71, 76, 85, 87 and 92 have been amended herein to recite "consisting of". The claims have further been amended to recite that the molluscs repelled by the composition and method of the present invention are from the families *Agriolimidae* and *Helicadae*, *i.e.*, slugs and snails. The claims also recite the treatment of an article above ground or in the soil. Support for these amendments can be found throughout the specification and claims as-filed, especially on page 11, disclosing the use of the method of the present invention on articles above ground or in the soil, and in the Examples on pages 11-17 (disclosing examples using molluscs from the families *Agriolimidae* and *Helicadae*). Accordingly, no prohibited new matter has been added.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 55-75 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly not enabled for all species of molluscs. This rejection is respectfully traversed.

In the interest of expediting prosecution, Applicants have amended rejected independent claim 55 herein to recite the treatment of an article above ground or in the soil, and wherein the mollusc to be repelled is from the family *Agriolimidae* or *Helicadae*. Thus, the molluscs of the claimed invention are enabled by the present specification. As claim 55 now recites methods of repelling molluscs from the families *Agriolimidae* and *Helicadae*, Applicants note that the Examples, provided in the specification on pages 11-18, provide detailed experiments using *Deroceras spp.* (the family *Agriolimidae*), *Helix spp.* and *Cernuella spp.* (both of the family *Helicadae*).

Further Applicants note that the rejected claims are drawn to the application of a molluscicidal composition to a substrate, and that there is no difficulty for the skilled artisan in applying an enabled composition to a substrate. Applicants further submit that exemplary molluscicides are described and enabled in the specification.

Thus, Applicants submit that the method of claims 55-75, as amended herein, are enabled by the specification, and request that this rejection be withdrawn.

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 55-60, 71-72, 74-81, and 92-94 stand rejected under 35 U.S.C. § 102(b) as purportedly anticipated, or alternatively, under 35 U.S.C. § 103(a) as obvious over Ikari *et al.* (European Patent No. 0485213). Claims 55-67, 71-72, 74-88, and 92-95 stand rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Ikari *et al.*

For proving anticipation, "anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention as arranged in the claims." Jamesbury Corp. v. Litton Industrial Products, Inc. 225 U.S.P.Q. 253, 256 (Fed. Cir. 1985). The cited reference does not describe or suggest all of the elements of the rejected claims, as discussed in greater detail below.

In order to establish a case of *prima facie* obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to modify the reference or combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference(s) must teach or suggest all of the claim limitations. *See* M.P.E.P. §2142. Applicants respectfully submit that these criteria have not been met in the present Office Action.

Specifically, Applicants traverse, as the cited reference fails to recite or even to suggest all of the elements of the claimed invention, as amended herein. The cited reference also fails to provide any expectation of success in practicing the claimed invention.

As discussed above, Applicants have amended independent claim 55 herein to recite the treatment of an article above ground or in the soil, and wherein the mollusc to be repelled is from the family *Agriolimidae* or *Helicadae*. These families of molluscs, as discussed in the present specification, comprise terrestrial organisms, such as slugs and snails.

In contrast, Ikari *et al.* is directed to marine organisms, and certainly does not disclose or suggest the families *Agriolimidae* or *Helicadae* or the treatment of articles which are above ground or in the soil as currently claimed in the present invention. Further, the terrestrial organisms of the presently claimed invention require different treatment, in contrast to those treatments successful against marine organisms. Thus, the skilled artisan would not be motivated to apply the methods of the cited reference to the terrestrial molluscs of the present invention, nor would they have an expectation of success. Applicants request that this rejection be withdrawn.

Objections to the claims

Claims 89-91 stand objected to as dependent upon a rejected base claim. Applicants note with appreciation that these claims would be allowable if rewritten into independent form. However, in light of the present Amendment, Applicants submit that the rejections against base claim 76 should be withdrawn, and the objections to the claims mooted.

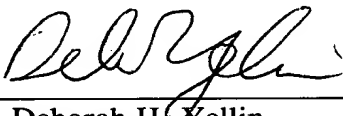
CONCLUSION

Based on the foregoing, this application is believed to be in condition for allowance. A Notice to that effect is respectfully solicited. However, if any issues remain outstanding after consideration of this Amendment and Reply, the Examiner is respectfully requested to contact the undersigned so that prosecution may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 28, 2003

By: 
Deborah H. Yellin
Registration No. 45,904

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620